



578-012A

Handwritten notes and signatures in the top right corner, including 'AF 3635' and '2/28/03'.

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

APPLICANT : STEVEN H. WALKER, ET AL.
SERIAL NUMBER : 09/896,505
FILED : JUNE 29, 2001
FOR : STRUCTURAL METAL MEMBER FOR USE IN A
ROOF TRUSS OR FLOOR JOIST
ART UNIT : 3635
EXAMINER : BASIL S. KATCHEVES

TO: ASSISTANT COMMISSIONER OF
PATENTS & TRADEMARKS
WASHINGTON DC 20231

ATT: BOARD OF APPEALS

SIR:

Enclosed please find an original and two copies of an Appeal Brief in the above identified matter, together with a check in the amount of \$160.00 to cover the filing fee.

Respectfully submitted,

STEVEN H. WALKER, ET AL. - Applicant

Notice: This correspondence is being deposited with the United States Postal Service at first class mail in an envelope addressed to: Assistant Commissioner of Patents, Wash. DC 20231 01/28/03

(Date of Deposit)

CLIFFORD G. FRAYNE

Name of applicant, assignee, or
Registered Representative

Signature

Date of Signature

By:

CLIFFORD G. FRAYNE #27,637
136 Drum Point Road, Suite 7A
Brick, NJ 08723
(732) 262-2075



578-012A

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

APPLICANT : STEVEN H. WALKER, ET AL.
SERIAL NUMBER : 09/896,505
FILED : JUNE 29, 2001
FOR : STRUCTURAL METAL MEMBER FOR USE IN A
ROOF TRUSS OR FLOOR JOIST
ART UNIT : 3635
EXAMINER : BASIL S. KATCHEVES

APPEAL BRIEF

RECEIVED
FEB 07 2003
GROUP 3600

TO: ASSISTANT COMMISSIONER OF
PATENTS & TRADEMARKS
WASHINGTON DC 20231

ATT: BOARD OF APPEALS

SIR:

This is an appeal from the Office Action (final) dated
October 10, 2001.

REAL PARTY IN INTEREST

Steven H. Walker and Raymond C. Frobosilo, the named
inventors, are the real party in interest.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF ALL CLAIMS

Claims 1 through 11 were initially filed and pending in the application. Claims 1 through 11 stand finally rejected and are the appeal claims.

STATUS OF ALL AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION

A Rule 116 Amendment was filed in an attempt to clarify Applicant's position. The Rule 116 Amendment was not entered.

SUMMARY OF THE INVENTION

Applicant's invention is a cold formed, sheet metal structural member having a first planar web member (page 5, line 10, Ref #12) with two extending legs (page 5, line 12, Ref #'s 18 and 20) such that the structural member or chord comprises an elongated member of substantially U-shaped cross section being longitudinally symmetric and being closed at one end and open at the other end, the legs are mirror images of each other and terminate without outwardly extending hollow flanges (page 5, line 13, Ref #'s 22 and 24) having a margin area (page 5, line 14, Ref #'s 26 and 28) juxtaposed to the respective leg. As an additional embodiment a bracing web member (page 7, line 5, Ref #50) is

slidably receivable within the U-shaped cross section and can be secured to the depending legs by suitable fasteners and a secondary web is positionable on the structural member in parallel relationship to the first web (page 7, lines 8-12, Ref #'s 50 and 14) to provide additional resistance for sheathing fasteners.

STATEMENT OF ALL ISSUES PRESENTED FOR REVIEW

1. Does the Dolati reference in view of the Seccombe reference obviate Claims 1 through 11 under 35 U.S.C. §103?

GROUPING OF CLAIMS FOR EACH GROUND OF REJECTION

The claims stand or fall together.

CLAIMS ON APPEAL

Claims 1 through 11 are set forth in the attached Appendix. The following Claim 1 is the independent claim on appeal:

1. An elongate metallic structural member having an elongate, planar web surface having longitudinal edges; a first leg member and a second leg member depending to one side of said web member from said longitudinal edges, said first leg member and said second leg member being mirror images, said first leg member and said second leg member terminating with outwardly extending hollow flanges, each outwardly extending flange having a margin member juxtaposed said respective leg member.

APPELLANT'S ARGUMENT

A. OBVIOUSNESS UNDER 35 U.S.C. §103

In Graham v. John Deere Co., Inc. 381 US 1 (1966) the Supreme Court established at least three (3) criteria to be evaluated before reaching a prima facie conclusion of obviousness under 35 U.S.C. §103(a). The criteria involve a fact determination of (1) scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) level of ordinary skill in the pertinent art. The first criterion is a two-fold consideration: scope of the prior art and content of the prior art. Scope of the prior art has been defined as that reasonably pertinent to the particular problem with which the inventor was involved. Applicant was addressing the problem of developing a cold rolled metal structural member in which would provide for stability and present a plurality of web surfaces for securing sheathing fasteners therethrough thus insuring enhanced frictional engagement of the fastener to the structural member.

Dolati and Seccombe are both directed to metal structural members albeit seeking advantages other than those of Applicant which explains the structural differences.

The next criterion of Graham v. John Deere supra is the
}

difference between the prior art and the claimed invention. Applicant's invention relates to a structural member having a web member and two leg members extending from the same side of the web member and terminating with outwardly extending hollow flanges with a margin member juxtaposed the respective leg members.

Dolati discloses a web with two leg members extending from the same side thereof and terminating with outwardly extending open flanges. In the preferred embodiment these open flanges are curved. (Figure 1, Ref #9, 9A, 9B, 13, 13A, 13B; Figure 2, Ref #9 and 13; Claim 14). Still further, there is no leg portion which closes the flange with one of the depending legs from the web and no margin juxtaposed the respective leg member.

Considering Seccombe there is disclosed a metal structural member. The Examiner admits that Dolati neither teaches nor suggests a third flange leg with margin, but the Examiner relies on the combination with Seccombe to render this aspect allegedly obvious. The Examiner states "...Seccombe discloses an elongated metallic structural member having a third side flange member (Fig. 1: 19) which terminates with a margin member juxtaposed to the leg member."

An examination of Seccombe, Figure 1, reveals that flange

wall, Ref #19, is not "a third side flange", but rather a flange wall extension from web 9. Flange 11 is comprised of four flange walls 19, 20, 21 and 22, and flange wall 22 terminates with a margin 23 juxtaposed "web" 9 and not juxtaposed a leg member. In fact, Seccombe does not mention nor label a leg member.

Any attempt to utilize this analysis with respect to flange 10 of Seccombe must similarly fail. Flange 10 is five sided with margin 17 integral with flange wall 16. Still further it is clear from the language of Applicant's Claim 2 that the flange walls are oriented in a manner totally dissimilar from the angled walls of Seccombe or the arced flanges of Dolati. It is respectfully submitted that the combination of Dolati and Seccombe does not obviate Claims 1-5, 7, and 9-11.

Dolati is U-shaped in cross section having base Ref #2 and two legs Ref #'s 3 and 4 and arcuate open flanges 9 and 13. The load bearing surface to which sheathing would be applied in Dolati would be base 2. The Seccombe reference has a web 9, no legs, and two flanges Ref #'s 10 and 11. The load bearing surface of Seccombe is flange wall 14 from which there does not depend two legs terminating in two hollow flanges with margin.

The Examiner also rejects Claims 3, 4, 5, 7, 9, and 10 based

on the Dolati reference arguing that it would have been obvious in view of Dolati, Figure 4, to add an additional web member. It should be pointed out that Dolati does not add an additional web member. Dolati adds reinforcers which are essentially parallel to the Dolati leg members and not parallel to the Dolati base Ref #2 which is the equivalent of the Applicant's web. The purpose of Applicant's additional web members is to provide for two parallel surfaces for engagement with the fasteners so as to provide for a more permanent engagement as opposed to one surface. The web members parallel to the legs is disclosed by Dolati, Figure 4, do not accomplish this purpose in that they are not the load bearing surfaces to which sheathing would be applied and is therefore respectfully submitted that the Examiner is in error in reliance on Dolati Figure 4 for the rejection of the aforesaid claims.

In the context of the last observations in Graham v. John Deere, Inc. *supra*, i.e. the level of ordinary skill in the pertinent art, it is respectfully submitted that one of ordinary skill in the art when studying the Dolati reference in combination with Seccombe, would not be led to the structure of Applicant.

It is therefore respectfully submitted that the combination

of Dolati and Seccombe are insufficient within the context of Graham v. John Deere, Inc. *supra* to render independent Claim 1 and the claims depending therefrom obvious under 35 U.S.C. §103.

CONCLUSION

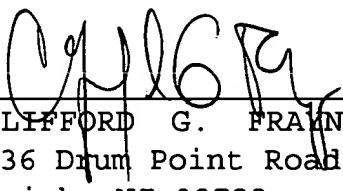
Claims 1 through 11 have been improperly rejected under 35 U.S.C. §103. Appellant respectfully requests that this Honorable Board of Appeals reverse the Examiner's final rejection of Claims 1 through 11 over the cited references.

A check in the amount of \$160.00 in payment of the appeal fee is enclosed herewith.

Respectfully submitted,

STEVEN H. WALKER, ET AL - Applicant

By:

 1/28/03
CLIFFORD G. FRAUNE #27,637
136 Drum Point Road, Suite 7A
Brick, NJ 08723
(732)262-2075

APPENDIX

1. An elongate metallic structural member having an elongate, planar web surface having longitudinal edges; a first leg member and a second leg member depending to one side of said web member from said longitudinal edges, said first leg member and said second leg member being mirror images, said first leg member and said second leg member terminating with outwardly extending hollow flanges, each outwardly extending flange having a margin member juxtaposed said respective leg member.

2. The elongate metallic structural member in accordance with Claim 1 wherein said outwardly extending hollow flanges are defined by said leg member, a first flange side member in a plane parallel with said web member, a second flange side member in a plane parallel with said leg member, and a third flange side member parallel to said first flange side member and said web member, said third flange side member terminating with said margin member juxtaposed to said leg member.

3. The elongate metallic structural member in accordance with Claim 2 wherein a second web member having an elongate planar web having longitudinal edges and having flange members depending

to one side from said longitudinal edges is positioned in substantially parallel relationship to said web surface.

4. The elongate metallic structural member in accordance with Claim 3 wherein said second web member is secured between said leg members.

5. The elongate metallic structural member in accordance with Claim 3 wherein said second web member is positioned above said web surface, said flanges of said second web member being secured to said leg members of said elongate metallic structural member.

6. The elongate metallic structural member in accordance with Claim 1 wherein said leg members depend perpendicularly from one side of said web surface for a distance and transition angularly towards opposing leg member for a distance and transition perpendicularly to said web member terminating in said outwardly hollow extending flanges.

7. The elongate metallic structural member in accordance with Claim 6 wherein said second web member is disposed between said leg members where said leg members transition angularly from the perpendicular.

8. The elongate metallic structural member in accordance

with Claim 1 wherein said leg members depend perpendicularly from one side of said web surface terminating in said outwardly hollow extending flanges.

9. The elongate metallic structural member in accordance with Claim 5 wherein said second flange side member of said hollow flanges is in the plane of said flanges of said second web member.

10. The elongate metallic structural member in accordance with Claim 6 wherein said second flange side member of said hollow flanges is in the plane of said leg member as it depend perpendicularly from one side of said web surface.

11. The elongate metallic structural member in accordance with Claim 2 wherein said margin member is secured to said leg member.